

REMARKS

I. Preliminary Matters

Claims 3-8, 12-17, and 21-33 have been examined. Claims 3-5 and 12-14 have been rejected under 35 U.S.C. § 102(e), and claims 6-8, 15-17, 21-28, and 30-32 have been rejected under 35 U.S.C. § 103(a). The Examiner has indicated that claims 29 and 33 would be allowable if rewritten in independent form.

Applicants thank the Examiner for withdrawing the Restriction Requirement of January 9, 2006. Also, Applicants thank the Examiner for entering the Preliminary Amendment filed on March 23, 2006.

Applicants note that the Examiner has not yet signed and initialed the PTO/SB/08 form attached to the Information Disclosure Statement submitted on April 13, 2005. Applicants respectfully request that the Examiner acknowledge consideration of the reference listed on this form in the next Office Action. Also, Applicants are submitting another copy of the form, as well as the date-stamped filing receipt, for the Examiner's convenience.

II. Rejection under 35 U.S.C. § 102(e) over U.S. Patent No. 6,798,997 to Hayward et al. ("Hayward")

Claims 3-5 and 12-14 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Hayward. Applicants respectfully traverse this rejection.

Claim 3 recites, *inter alia*, a method of determining a price at which a new expendable is to be supplied, comprising the step of "determining the price by the computer based on the model and the remaining amount of expendable included in the expendable-related information."

The Examiner acknowledges that Hayward does not expressly disclose determining the price based on the expendable-related information. However, the Examiner maintains that this feature is inherent in Hayward.

Hayward does not expressly or inherently disclose determining the price based on the model and the remaining amount of expendable included in the expendable-related information, as recited in claim 3. Assuming *arguendo* that determining the price of the expendable is inherent in Hayward, determining this price based specifically on a particular model and the remaining amount of expendable is not inherent in Hayward. Therefore, Applicants submit that claim 3 is patentable over Hayward for at least these reasons.

Independent claims 5, 12, and 14 recite limitations that are similar to those present in claim 3 as discussed above. Therefore, claims 5, 12, and 14 are patentable over Hayward for similar reasons. Further, claims 4 and 13 are also patentable over Hayward, at least by virtue of their respective dependencies on claims 3 and 12.

III. Rejection under 35 U.S.C. § 103(a) over Hayward and U.S. Patent No. 5,657,678 to Cohen ("Cohen")

Claims 6-8, 15-17, 21-28, and 30-32 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hayward in view of Cohen. Since claims 6 and 15 contain features that are similar to the features discussed above in conjunction with claim 3, and since Cohen does not cure the deficient teachings of Hayward with respect to claim 3, independent claims 6 and 15 are patentable for similar reasons. Also, claims 7, 8, 16, and 17 are patentable at least by virtue of their dependencies on claims 6 or 15.

Independent claim 21 recites, *inter alia*, a computer program that causes “the computer to verify whether a first type order has been submitted to the supplier for the expendable container before, the first type order being for providing a new expendable contained in a new expendable container on condition that the expendable container possessed by the user is returned to the supplier.” Further, claim 21 specifies a price difference for a first type order in which the user returns an expendable container to the supplier, in comparison with a second type order in which the user does not return an expendable container to the supplier.

The Examiner acknowledges that Hayward does not expressly disclose providing a first price if the user returns a used cartridge to the supplier, and a second price if the user does not return a used cartridge to the supplier. However, the Examiner argues that Cohen discloses a price difference between a cartridge with recycling and a cartridge without recycling, and that Cohen provides a motivation to combine of reducing cost and wastefulness. Applicants respectfully disagree.

Cohen is directed towards a tool that enables consumers to replenish and recycle cartridges without returning them to the supplier (col. 1, lines 48-50). As the Examiner discusses, Cohen mentions that a consumer can buy a recycled cartridge for one half or less of the price of a new cartridge (col. 1, lines 43-45). However, in this situation, the consumer must send the used cartridge to another facility or back to the manufacturer for recycling (col. 1, lines 45-47). In contrast, the tool of Cohen allows the consumer to open and refill a used cartridge without sending the cartridge back to the supplier (col. 1, lines 51-60).

Cohen does not teach or suggest basing the price of a new expendable on the return of an expendable already possessed by the user, as recited in claim 21. Instead, Cohen teaches away from this feature, because the tool of Cohen is designed to enable the consumer to replenish and recycle a used cartridge without returning the cartridge to the supplier. Therefore, because neither Hayward nor Cohen teach or suggest basing the price of a new expendable on the return of an expendable already possessed by the user, claim 21 is patentable over Hayward, Cohen, and their combination.

Independent claims 23 and 30 recite limitations that are similar to those present in claim 3 as discussed above. Therefore, claims 23 and 30 are patentable over Hayward, Cohen, and their combination for similar reasons. Further, claims 22, 24-29, and 31-33 are also patentable over Hayward and Cohen, at least by virtue of their respective dependencies on claims 21, 23, and 30.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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CUSTOMER NUMBER

Grant K. Rowan
Registration No. 41,278

Date: October 19, 2006